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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,871

03/16/2004

Sung-hee Hwang

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,871	Applicant(s) HWANG ET AL.	
	Examiner Jorge L. Ortiz-Criado	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species (a) Fig. 4, claims 1-22, in the reply filed on 07/13/2007 is acknowledged.

The traversal is on the ground(s) that:

(1) No references were cited to show necessity of restriction.

This is not found persuasive because as provided in MPEP § 808.01 Species:

-- Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner.

There must be a patentable difference between the species as claimed. See MPEP § 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. A single disclosed species must be elected as a prerequisite to applying the provisions of 7 CFR 1.141 to additional species if a generic claim is allowed.

As provided in MPEP § 808.02 (C)

-- Patents need not be cited to show different fields of search.

Accordingly, it is not required to show references to show necessity of restriction.

(a) The outstanding Office Action merely does not establish the appropriate explanation statement in that the application directed to the patentably distinct species.

This is not found persuasive because as provided in MPEP § 809.02 (a) reproduced below:

"Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted."

The Examiner clearly identifies in the Office Action the distinct species of the claimed the invention and supporting such finding by providing figures that clearly identify the distinct species of the invention the species were conveniently identified with the figures. The examiner further recognizes that species a and b are materially different in embodiment designs as described with respect to the corresponding identified figures having different modes of operations, functions and effects of the method and apparatus for recording the optical recording medium, which are not an obvious variant of species.

As provided in MPEP § 808.01 Species: *Election of species should not be required between claimed species that are considered clearly unpatentable (obvious) over each other.* In the instant case the species are identified to be not an obvious variant of species.

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The requirement is still deemed proper and is therefore made FINAL.

Claims 23-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 07/13/2007.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 22 define a program stored in a carrier wave with descriptive material as defined in the specification on page 19, paragraph [0091]. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium, a carrier wave (i.e., signal) embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ko et al. U.S. Patent No. 6,160,778.

Claims 1-22 recites “temporary defect information with a size equal to a multiple ($N=0,1,2, \dots$)” of size (K) and further recites “remaining temporary defect information, excluding the temporary defect information with the size equal to $K \times N$ ”. From the alternative language ($N = 0,1,2, \dots$) in the claim, for an $N = 0$, the recording of temporary defect information on the recording medium would no have been performed, or the recording medium would have no temporary defect information recorded.

The claims are given their broadest reasonable interpretation and in light of the supporting disclosure and Applicant’s specification describes the size equal to $N = 0$.

From the case of the alternative language $N=0$.

Ko et al. discloses a recording method, corresponding apparatus, recording medium and corresponding tangible computer readable medium having stored a program thereon that separately records to an optical recording medium temporary defect information and size information (see Figures 2-17; col. 9, lines 24-31; col. 10, lines 6-41; col. 11, lines 30-36).

Before the recording medium is being process the recording of temporary defect information and size information on the recording medium would not have been performed, or the recording medium would have no temporary defect information recorded. Ko et al. discloses that it is temporary because is updated at every recording operation.

Hence, Ko et al. anticipates claims 1-22 as provided by the alternative language.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Fri 10:00 am- 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jorge L. Ortiz-Criado
Patent Examiner